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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,048	12/20/2001	Stephen M. Andrews	PP/1-22413/P2/CGC 2073	1670

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EXAMINER

SHORT, PATRICIA A

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

16/034048

Applicant(s)

Andrews et al

Examiner

Short

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 - 24 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 - 24 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3, 5
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 and 18-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese '959. The reference teaches compositions comprising polyester and ethylene vinyl alcohol copolymer that have suppressed aldehyde generation. Component (ii) polyhydric alcohol does not distinguish over small amounts of unreacted monomer, i.e. ethylene glycol, that would be present in the polyethylene terephthalate.

Claims 1-13 and 18-24 are rejected under 35 U.S.C. 102(b) as being anticipated by French '199. The reference teaches stabilized compositions comprising polyester and polyacrylamide. See example 8. Component (ii) polyhydric alcohol does not distinguish over small amounts of unreacted monomer, i.e. butylene glycol and bisphenol A, that would be present in the polybutylene terephthalate and polycarbonate.

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Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '659 taken with of JP '959. WO '659 teaches compositions comprising polyester and compounds containing at least two hydroxyl groups that have suppressed aldehyde generation. JP '959 teaches compositions comprising polyester and ethylene vinyl alcohol copolymer that have suppressed aldehyde generation. From the combined teachings of the references, it would have been obvious to add a combination of a compound having at least two hydroxyl groups with an ethylene vinyl alcohol copolymer, taught by the prior art for the same purpose, to a polyester in order to suppress aldehyde generation. See *In re Kirkhoven* 205 USPQ 1069 (CCPA 1980).

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werner in view of JP '959. Werner teaches compositions comprising polyester and a carbohydrate that have aldehyde generation equal to or less than the polyester alone. See col. 2, lines 26-30 and example 7. JP '959 teaches compositions comprising polyester and ethylene vinyl alcohol copolymer that have suppressed aldehyde generation. In view of Japanese '959, it would have been obvious to add ethylene vinyl alcohol copolymer to the compositions of Werner in order to bring about further reduction in aldehyde generation.

Claims 1-13 and 18-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Andrews. The reference teaches compositions comprising polyester and poly(vinyl alcohol) or ethylene/vinyl alcohol copolymer that have suppressed aldehyde generation. Component (ii) polyhydric alcohol does not distinguish over small amounts of unreacted monomer, i.e. ethylene glycol, that would be present in the polyethylene terephthalate.

Claims 1-13 and 18-24 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09/666,679 which has a common inventor with the

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instant application. The reference teaches compositions comprising polyester and polyacrylamide that have suppressed aldehyde generation. Component (ii) polyhydric alcohol does not distinguish over small amounts of unreacted monomer, i.e. ethylene glycol, that would be present in the polyethylene terephthalate.

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future patenting of the copending application.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andrews taken with WO '659. Andrews teaches compositions comprising polyester and poly(vinyl alcohol) or ethylene/vinyl alcohol copolymer that have suppressed aldehyde generation. WO '659 teaches compositions comprising polyester and compounds containing at least two hydroxyl groups that have suppressed aldehyde generation. From the combined teachings of the references, it would have been obvious to add a combination of a compound having at least two hydroxyl groups with an ethylene vinyl alcohol copolymer, taught by the prior art for the same purpose, to a polyester in order to suppress aldehyde generation. See *In re Kirkhoven* 205 USPQ 1069 (CCPA 1980).

Claims 1-24 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 09/666,679 which has a common inventor with the instant application

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taken with WO '659 or JP '959. S.N. 09/666,679 teaches compositions comprising polyester and polyacrylamide that have suppressed aldehyde generation. WO '659 teaches compositions comprising polyester and compounds containing at least two hydroxyl groups that have suppressed aldehyde generation. JP '959 teaches compositions comprising polyester and ethylene vinyl alcohol copolymer that have suppressed aldehyde generation. From the combined teachings of the references, it would have been obvious to add a combination of polyacrylamide and a compound having at least two hydroxyl groups or ethylene vinyl alcohol copolymer, taught by the prior art for the same purpose, to a polyester in order to suppress aldehyde generation. See *In re Kirkhoven* 205 USPQ 1069 (CCPA 1980).

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if published or patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future publication or patenting of the conflicting application.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Claims 1-24 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 10/209,353 which has a common inventor with the instant application taken with JP '959. S.N. 10/209,353 teaches compositions comprising polyester and polyhydric alcohol that have suppressed aldehyde generation. JP '959 teaches compositions comprising

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polyester and ethylene vinyl alcohol copolymer that have suppressed aldehyde generation. From the combined teachings of the references, it would have been obvious to add a combination of a polyhydric alcohol with an ethylene vinyl alcohol copolymer, taught by the prior art for the same purpose, to a polyester in order to suppress aldehyde generation. See *In re Kirkhoven* 205 USPQ 1069 (CCPA 1980).

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if published or patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future publication or patenting of the conflicting application.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,191,209 in view of WO '659. WO '659 teaches compositions comprising polyester and compounds containing at least two hydroxyl groups that have suppressed aldehyde generation. It would have been obvious to add a compound having at least two hydroxyl groups, taught by the prior art for the same purpose, to the claimed polyester composition in order to suppress aldehyde generation. See *In re Kirkhoven* 205 USPQ 1069 (CCPA 1980).

Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 09/666,679 in view of WO '659 or JP '959. WO '659 teaches compositions comprising polyester and compounds containing at least two hydroxyl groups that have suppressed aldehyde generation. JP '959 teaches compositions comprising polyester and ethylene vinyl alcohol copolymer that have suppressed aldehyde generation. It would have been obvious to add a compound having at least two hydroxyl groups or ethylene vinyl alcohol copolymer, taught by the prior art for the same purpose, to a claimed polyester composition in order to suppress aldehyde generation. See *In re Kirkhoven* 205 USPQ 1069 (CCPA 1980).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/209353 in view of JP '959. JP '959 teaches compositions comprising polyester and ethylene vinyl alcohol copolymer that have suppressed aldehyde generation. It would have been obvious to add an ethylene vinyl alcohol copolymer, taught by the prior art for the same purpose, to a claimed polyester composition in order to suppress aldehyde generation. See *In re Kirkhoven* 205 USPQ 1069 (CCPA 1980).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 18 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 18 is broader than claim 1 in that claim 1 requires group (iii) additive that is polyacrylamide, polymethacrylamide or copolymer of acrylamide or methacrylamide with at least one ethylenically unsubstituted monomer while claim 18 encompasses any polymer containing a polymerized acrylamide or methacrylamide unit.

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